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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,411	01/02/2001	Eric D. Bergman	0007056-0053/P5278/ARG	3148
26263	7590	01/13/2005	EXAMINER	
SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			HUYNH, CONG LAC T	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/754,411

Applicant(s)

BERGMAN ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment filed 7/23/04 to the application filed on 1/2/01.
2. Claims 1-24 are pending in the case. Claims 1, 9, 17 are independent claims.
3. The objections of claims 9 and 16 because of the informalities have been withdrawn in view of the amendment.
4. The rejections of claims 9-15 under 35 U.S.C. 101 have been withdrawn in view of the amendment.
5. The rejections of claims 1-8, 17-24 under 35 U.S.C. 112, second paragraph, have been withdrawn in view of Applicant's arguments.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-3, 5-11, 13-19, 21-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sragner (US Pat No. 6,272,485 B1, 8/7/01, filed 2/19/99).

Regarding independent claim 1, Sragner discloses:

- creating an original document on a computer (col 1, lines 17-24, col 2, lines 52-54, col 2, line 66 to col 3, line 7: documents transferred from central document server to remote document users suggests that the document is already created at a central computer)
- transferring said original document to a disconnected device (col 1, lines 17-24, col 2, lines 52-54, col 2, line 66 to col 3, line 7, col 5, lines 1-7; it is noted that the computer at the remote terminal, when unplugged or turned off is considered as a disconnected device while the original is transferred to it)
- modifying said original document on said disconnected device to form a modified document (col 1, lines 17-24, col 5, line 63 to col 6, line 3, col 8, lines 9-18: edit the received document at the client computer; col 3, lines 42-46: modify the received document by entering data into data fields of the document at the client)
- returning said modified document to said computer (col 8, lines 9-18, col 3, lines 1-7, 42-46)

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Sragner does not explicitly disclose determining one or more modification between said original document and said modified document.

Instead, Sragner discloses that the present invention as well as the various embodiments of the invention include methods and systems which send documents from the central server to a remote user where the user can modify the received documents and return to the central server (col 3, lines 30-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Sragner to include determining one or more modification between said original document and said modified document since the fact that entering data into the data fields of the received document, which is the original document, suggests that determining one modification before actually modifying the original document and the modified document.

Regarding claim 2, which is dependent on claim 1, Sragner discloses utilizing change tracking software (col 8, lines 18-26: the fact that the CGI data extracting script that *reads the data entered into the data fields and update the database file with the extracted data* by opening and amending the database file suggests a change tracking software since the entered data to the document is the change to the document, and the system via extracting scripts recognize such change to amend the database file).

Regarding claim 3, which is dependent on claim 1, Sragner discloses utilizing a data translation operation (col 8, lines 18-26: as mentioned in claim 2, reading the data

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entered into the data fields and update the database file with extracted data are data translation operations).

Regarding claim 5, which is dependent on claim 1, Sragner discloses integrating said modifications into said original document (col 3, lines 42-46: the entered data to the data fields is the modification integrated to the received document, which is the original document, col 8, lines 15-17: the fact that the blank fields are inserted with data shows the modification integrated into the original document). Sragner does not explicitly disclose determining whether to integrate said modification into said original document. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Sragner to include said determining since said integrating is performed suggests determining a decision of integrating said modifications into said original document be carried out before actually integrating.

Regarding claim 6, which is dependent on claim 1, Sragner discloses merging said original document and said modified document (col 3, lines 1-7, 42-46, col 8, lines 9-18: the fact that the original document is modified and returned to the central server that includes the original document suggests merging said original document and said modified document since the returned document by itself is a modified document of merging of the original document and data).

Regarding claim 7, which is dependent on claim 1, Sragner discloses said original document was created using an office productivity application (col 3, lines 18-21: the documents are made available in plural formats of Microsoft Word, WordPerfect, Microsoft Excel...).

Regarding claim 8, which is dependent on claim 1, Sragner discloses said document was modified using a companion application (col 5, line 63 to col 6, line 3: using word processor, spreadsheet to edit documents).

Claims 9-11, 13-16 are for a change tracker of method claims 1-3, 5-8, and are rejected under the same rationale.

Claims 17-19, 21-24 are for a computer program product of method claims 1-3, 5-8, and are rejected under the same rationale.

9. Claims 4, 12, 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sragner as applied to claim 1, 9, 17 above, and further in view of in view of Oprescu-Surcobe (US Pat No. 6,356,961 B1, 3/12/02, filed 6/3/94).

Regarding claim 4, which is dependent on claim 1, Sragner does not disclose that said disconnected device comprises a PDA.

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Oprescu-Surcobe discloses that individuals can transmit, receive, write to modification to a document to create an edited version and the edited version can be communicated back to the source and to other devices on the network (col 1, lines 38-43). Oprescu-Surcobe also discloses that the devices where to perform the above operations can be computer based devices such as personal computer, desktop computers, or personal digital assistants (PDAs).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Oprescu-Surcobe into Sragner for expanding the use of different computer-based devices, e.g. PDA, to perform various operations on documents, not limited to personal computer, which is a conventional device.

Claims 12 and 20 are for a change tracker and a computer program product of method claim 4, and are rejected under the same rationale.

Response to Arguments

10. Applicant's arguments filed 7/23/04 have been fully considered but they are not persuasive.

Applicants argue that Sragner does not teach or suggest a "disconnected device" since the remote terminal in Sragner, when unplugged or turned off, can not be considered a "disconnected device" (Remarks, page 8).

Examiner respectfully disagrees.

The claims must be interpreted as broadly as their terms reasonably allow during examination. See MPEP 2111.01:

"While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. > In re American Academy of Science Tech Center, ___ F.3d ___, 2004 WL 1067528 (Fed. Cir. May 13, 2004)"

Also, since the limitations in the specification are not read into the claims, the claims are given the broadest reasonable interpretation consistent with the specification. The fact that the remote computer in Sragner is a computer device shows that the claim interpretation is consistent with the specification where the disconnected device is mentioned as a computer-like device. Therefore, to consider a disconnected device a PDA as disclosed in the specification, said limitation should be included in the claims.

Applicants also argue that Sragner does not teach or suggest determining one or more modifications between the original document and the modified document via entering data into a data fields. Applicants further argue that determining a modification involves different methods, software, and resources than simply creating a modification (Remarks, page 9).

Examiner respectfully disagrees.

Sragner discloses that the present invention as well as the various embodiments of the invention include methods and systems which send documents from the central server

to a remote user where the user can modify the received documents and return to the central server (col 3, lines 30-46).

The fact that making a modification by entering data into one of the data fields of the received document, which is the original document, suggests that determining one modification between the original document and the modified document be made by a user before actually modifying data in the document or the modified document.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Moon (US Pat No. 6,771,980 B2, 8/3/04, filed 12/1/00).

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Challa et al. (US Pat No. 6,396,481 B1, 5/28/02, filed 4/19/99).

Moriya (US Pat No. 6,345,298 B1, 2/5/02, filed 7/5/00).

Mak et al. (US Pat App Pub No. 2004/0205539 A1, 10/14/04, filed 9/7/01).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Clh
12/30/04


STEPHEN HONG
SUPERVISORY PATENT EXAMINER